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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,571	10/17/2001	Motoki Kato	450100-4886.1	7985

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NEW YORK, NY 10151

EXAMINER

YOUNG, WAYNE R

ART UNIT	PAPER NUMBER
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2652

DATE MAILED: 02/25/2004

19

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/982,571

Applicant(s)

KATO, MOTOKI

Examiner

W. R. Young

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18,22-24,26-28,30-32,34-36,38-40 and 44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18,22-24,26-28,30-32,34-36,38-40 and 44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/313,100.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. The proposed drawing correction filed on 3/7/02 has been approved by the examiner. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

**New formal drawings are required in response to this office action.**

2. Applicant's arguments filed 12/20/02 have been fully considered but they are not persuasive for the reasons advanced in the Final office action mailed 10/21/03:

"Applicant argues that the new claims are allowable because they include limitations the Examiner allowed in parent case 09/313,100. First, it is noted that the limitations now claimed are not as specific as those previously allowed by the examiner. Thus, the argument as to patentability is not convincing. Second, the claims in case 09/313,100 were drawn to a reproducing apparatus as shown in figure 12, whereas the claims elected for prosecution in this case in response to the Restriction requirement were drawn to a recording apparatus as shown in figure 7. Applicant should note that filing an RCE merely removed the Finality of the last office action and not the election. The election of the recording apparatus carries forward. Inasmuch as applicant intended to claim the reproducing apparatus, all the current claims would be considered to be clearly drawn to a non-elected invention and the amendment of 12/20/02 held as non-responsive to the previous office action. Inasmuch as applicant intended to claim a combination recording/reproducing apparatus, the current claims as evidenced by at least claim 22 are patentably distinct from the elected recording apparatus that required extracting means and clock generating means not required by the combination evidence claim 22 and the parent 09/313,100 case reproducing apparatus which required additional patentable limitations noted,

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*supra*. The subcombinations each have separate utility with servo control or camera apparatus. Thus, all the current claims would be considered to be clearly drawn to a non-elected invention and the amendment of 12/20/02 held as non-responsive to the previous office action. Inasmuch as applicant is arguing patentability based on the record of the 09/313,100 case, the current claims should be amended to actually recite the same allowable language as that of the parent case, to recite the recording apparatus as originally elected so as not to be drawn to a patentably distinct invention therefrom, and a Terminal Disclaimer filed. Inasmuch as the claims could be interpreted as still claiming a recording apparatus as originally elected, the following action is made.”

3. Applicant's arguments filed 1/23/04 with the instant RCE have been fully considered but they are not persuasive.

Applicant argues that the new claims are allowable because they include the limitation, “wherein when said arrival time stamp is discontinuous, output timing of the transport packet is controlled in accordance with the discontinuity information” (claim 18, other claims include similar language), which is not found in the recording apparatus of figure 7. It appears that this feature may read on the reproduction apparatus shown in figure 12. The claims elected for prosecution in this case in response to the Restriction requirement were drawn to a recording apparatus as shown in figure 7. Applicant should note that filing an RCE merely removed the Finality of the last office action and not the election. The election of the recording apparatus carries forward. Inasmuch as applicant intended to claim the reproducing apparatus, all the current claims would be considered to be clearly drawn to a non-elected invention and the amendment of 1/23/04 held as non-responsive to the previous office action. Inasmuch as

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applicant intended to claim a combination recording/reproducing apparatus, the current claims as evidenced by at least claim 22 are patentably distinct from the elected recording apparatus that required extracting means and clock generating means not required by the combination evidence claim 22. The subcombination elected recording apparatus has separate utility with servo control or camera apparatus. Thus, all the current claims would be considered to be clearly drawn to a non-elected invention and the amendment of 1/23/04 held as non-responsive to the previous office action. Inasmuch as the claims could be interpreted as still claiming a recording apparatus as originally elected, the following action is made.

With regard to the argument as to the art rejections, it is noted that "an external clock" is not specified in claims 26-28 and 38-40.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 18, 22, 23-24, 26, 27-28, 30, 31-32, 34, 35-36, 38, 39-40, and 44 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention and/or are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.


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Claim 22 (claims 18, 26, 30, 34, 38, and 44 recite similar language) recites time-stamp generator, formatting unit, and information generator, all drawn to the recording apparatus shown in figure 7. Claim 22 (claims 18, 26, 30, 34, 38, and 44 recite similar language) also recites, "wherein when said arrival time stamp is discontinuous, output timing of the transport packet is controlled in accordance with the discontinuity information" which is not found in the recording apparatus of figure 7. It appears that this feature may read on the reproduction apparatus shown in figure 12. Dependent claims 23-24 (dependent claims 27-28, 31-32, 35-36, and 39-40 recite similar language) recite a playback management file not found in figure 7, but which may be in reproducing apparatus figure 14. Thus, the claims are either not adequately disclosed or are misdescriptive of what is disclosed and therefore indefinite.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to W. R. Young whose telephone and VoiceMail number is (703) 308-1554. If a plurality of attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen, can be reached on (703) 305-9687.

The appropriate fax phone number for the organization (Group 2650) where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700 or the Group Customer Service section whose telephone number is (703) 306-0377.



**WAYNE R. YOUNG**  
**PRIMARY EXAMINER**  
**ART UNIT 2652**

wry/wry  
2/20/04